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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,868	01/24/2000	Sam E. Kinney JR.	046700-5012	7745

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EXAMINER

FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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2164

DATE MAILED: 02/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/490,868

Applicant(s)

KINNEY ET AL.

Examiner

Daniel S Felten

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 06 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-5, 7-14, 16-23 and 25-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-49 of U.S. Patent No. 6,199,050 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because Alaia et al discloses a method/system, computer program of conducting an online auction between a plurality of potential bidders (potential sellers and a buyer; (see fig. 3), comprising the steps of: (a) receiving a plurality of bids from bidders/sellers (see claim 1, col. 27, lines 37+; and figs. 3, col. 3, lines 29-32 and lines 46-

1 53); (b) ranking/comparing the bids in order of attractiveness (see current best bid, fig. 8,
2 col. 4, lines 52-60); and (c) for each bid, displaying the rank determined in step (b) to the
3 bidder who made the bid (see col. 3, line 64 to col. 4, line 11); (d) transforming the bid into a
4 buyer comparative bid parameter (see Event code, col. 4, lines 52-60);

5 as in claims 2, 11, 20, 29, and 34, a method, system, and computer system which
6 determines an ordinal rank for each bid that is displayed to the bidder (see fig. 8, col. 4, lines
7 52-60; col. 9, lines 3-11; col. 13, lines 53-67; and col. 14; lines 41-49);

8 as in claims 3, 12 and 21, comprises the step of ranking the bids in accordance with
9 the price of the bids (see fig. 8, col. 4, lines 52-60);

10 as in claims 4, 13 and 22, comprising the step of transforming a bidder comparative
11 bid parameter into a comparative bid parameter for the originator of the auction (see col. 3,
12 lines 24-32);

13 as in claims 5, 14, 23 and 35, comprises a step of receiving transformed bid
14 information (see figs. , col. 8, lines 41-65);

15 as in claim 7, 16 and 25, comprising the additional step of transmitting the rank to the
16 bidder (see figs. , col. 3, lines 64 to col. 4, line 11);

17 as in claim 8, 17, 26 and 30 comprising the additional steps of repeating steps (b) and (
18 c) as new bids are received (see col. 4, lines 61-65);

1 as in claim 9, 18, 27, 32 and 37 comprises the step of displaying a tie rank to the
2 bidder if the ranking in step (b) results in a tie (see fig. 8); and

3 as in claims 31 and 36, further comprising means for displaying a tie rank to the seller
4 if a new bid results in a tie rank (see fig. 8).
5

6 3. Claims 6, 15 and 24 are rejected under the judicially created doctrine of obviousness-
7 type double patenting as being unpatentable over claims 1-49 of U.S. Patent No. 6,199,050 B1
8 in view of Togher et al (US 6, 014,627).

9 Alaia et al discloses all the limitation of the claims but fails to explicitly discloses, as in
10 claims 6, 15 and 24, the step of receiving a bid price in a base currency, wherein the bid price
11 is originally defined in a local currency of the first bidder. Togher et al teaches a
12 receiving/bidding at a base price in a base currency, wherein the bid price is originally defined
13 in a local currency of the first bidder (col. 6, line 41 to col. 7, line 65). To integrate the
14 feature of foreign currency conversion found in Togher et al into the invention of Alaia et al
15 would have been obvious because an artisan at the time of the invention of Alaia et al would
16 recognize that vendors/sellers/bidders connected over the Internet to the system could be from
17 different countries. Thus such countries would have different currencies, and have sought to
18 use Togher et al's system to convert one currency into another over the Internet.
19

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Daniel S. Felten** whose telephone number is (703) 305-0724. The examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday. Any inquiry of a general nature relating to the status of this application or its proceedings should be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor **Vincent Millin** whose telephone number is (703) 308-1065.

5. Response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

for formal communications intended for entry, or (703) 305-0040, for informal or draft communications, please label "Proposed" or "Draft".

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to *[daniel.felten@uspto.gov]*.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly

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Applicant(s): Kinney, Jr. et al (705/37)

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Representative: Boswell, M. 33,652 (33,652)

1 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
2 Trademark on February 25, 1997 at 1 195 OG 89.

3 

4 DSF

5 February 11, 2002


VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
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